



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,591	01/13/2006	Yaacov Almog	200209944-4	2055

22879 7590 03/04/2011

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
----------	--------------

1715

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

03/04/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JERRY.SHORMA@HP.COM
ipa.mail@hp.com
laura.m.clark@hp.com

Office Action Summary	Application No. 10/564,591	Applicant(s) ALMOG ET AL.	
	Examiner William P. Fletcher III	Art Unit 1715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/13/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-8 and 11-17 in the reply filed on 15 December 2010 is acknowledged. The traversal is on the ground(s) that the non-elected claims depend from elected claim 1 and should be rejoined. This is not found persuasive because claims 18-20 are product-by-process claims, where patentability is dependent on the product, not the process by which it is produced. See MPEP 2113. With respect to claims 21-24, the burden on the Primary Examiner further extends to the patentability issues associated with, and evolving as a result of, searching additional inventions. The process of producing the substrate used in the printing process of claims 21-24 has no bearing on the particulars of the printing process itself, and it is the necessity of searching and evaluating printing process, which fall not only within class 427, but classes 101 and 347 as well, in examining these claims — a search that is NOT required for the elected claims — that presents an undue burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 9 and 18-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species and inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 15 December 2010.

Information Disclosure Statement

3. The Primary Examiner has considered the IDS filed 13 January 2006.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 7, 8, 11, and 12, are rejected under 35 U.S.C. 102(b) as being anticipated by Lambert (US 5,656,378 A).

A. Claim 1 This reference teaches the claimed process in which a substrate is coated with a solution/dispersion of a polymer (i.e., a first material) and an amine-terminated mordant and dried. See 3:46-48 and 52-55.

B. Claim 4 This reference teaches a tri-primary amine. See 4:top.

C. Claim 7 This reference teaches propylene oxide-based triamines [4:top].

D. Claim 8 This reference teaches that the polymer may be poly vinyl alcohol. See 5:35.

E. Claim 11 This reference teaches that the substrate can be PET [5:12].

F. Claim 12 This reference teaches that the substrate can be polypropylene [5:10].

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1715

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2, 3, 5, 6, and 13-17, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lambert (US 5,656,378 A).

A. Claims 2, 3, 5, and 6

i. This reference does not expressly teach the mono/diamines claimed.

ii. It is the Primary Examiner's position that any known amine of suitable molecular weight [3:64-65] may advantageously be utilized in the process of Lambert.

iii. Consequently, it would have been obvious to one skilled in the art to utilize, as the amine mordant, the amines of these claims, motivated by the desire and expectation of similar results: the production of an amine mordant.

B. Claim 13

Art Unit: 1715

i. While this reference does not teach NaOH, it does teach pH adjustment via NH_4OH . See the Examples.

ii. It is the Primary Examiner's position that, since NaOH and NH_4OH are both known bases that may be used to lower the pH of a solution, it would have been readily obvious to one skilled in the art to substitute one for the other, with the expectation of similar results: pH adjustment.

C. Claims 14-17

i. This reference does not expressly teach the claimed concentration of amine material.

ii. The amount of amine material in the mordant is a result-effective material affecting the ink accepting ability of the sheet. Consequently, it would have been obvious to one skilled in the art to optimize this concentration by routine experimentation, absent evidence of criticality.

See MPEP 2144.05.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy H. Meeks can be reached on (571) 272-1423. The fax phone

Art Unit: 1715

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Phillip Fletcher III/
Primary Examiner, Art Unit 1715

28 February 2011